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IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
TAKASHI KARIYA, ET AL. : EXAMINER: NEIL ABRAMS
SERIAL NO: 10/564,200 :
FILED: JANUARY 11, 2006 : GROUP ART UNIT: 2839
FOR: INTERPOSER AND MULTILAYER :
PRINTED WIRING BOARD

REPLY BRIEF

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

This Reply Brief is in response to the Examiner's Answer mailed March 16, 2011. Appellants respectfully disagree with the "Response to Argument" section of the Examiner's Answer as follows:

Appellants' Brief filed November 26, 2010 presented arguments that the obviousness rejections in the Final Action are based on fact findings which are unsupported by substantial evidence, and therefore insufficient to support a *prima facie* case of obviousness. The Examiner's Answer repeats his position that the claimed features are "standard" or "typical" in the art, and implies that Appellants must show that the claimed features (such as the thickness ratio) are "not typical in the art." Appellants respectfully submit, however, that it is the Patent Office who bears the initial burden of providing substantial evidence to support fact findings. Appellants' position remains that this initial burden was never met by the Final Office Action, for the reasons stated in the Appellants' Appeal Brief.

Appellants' Brief also presented arguments that, even assuming that all claim features are separately within the prior art, the Final Action has not provided sufficient legal reasoning to support the obviousness conclusion. In particular, the Brief pointed out several advantages provided by the *combination of claim elements* recited in the appealed claims, and argued that these advantages are more than a predictable result, and thus provide non-obviousness. The Examiner's Answer does not address this reasoning, but rather simply concludes obviousness with little more than the findings that the features *individually* are "typical" and "standard." Appellants maintain that one of ordinary skill in the art would not find it obvious to combine the disparate teachings of the cited references without knowledge of some benefit for the combination, which is provided only within Appellants' specification.

For the reasons stated above and in Appellant's Appeal Brief, a reversal of the Examiner's rejections is respectfully requested.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, L.L.P.

A handwritten signature in black ink, appearing to read "E. Garlepp", is written over a horizontal line.

Edwin D. Garlepp
Attorney of Record
Registration No. 45,330